

/Erin Cowles/
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Appl. No.	:	09/547,561	Conf. No.:	6320
Applicant	:	Mathieu		
Filed	:	April 12, 2000		
TC/A.U.	:	2833		
Examiner	:	Alexander Gilman		

- The PTO issued a final Office Action dated October 31, 2006 (hereinafter the "2006 Final Office Action");
- Applicants filed an RCE and an Amendment dated January 31, 2007 in which claims 1, 16, 17, 90, and 91 were amended;
- The PTO issued a final Office Action dated April 12, 2007 (hereinafter the "Apr '07 Final Office Action");
- Applicants filed a Pre Appeal Brief Request For Review dated July 12, 2007;
- The PTO issued a Decision dated August 15, 2007 reopening prosecution; and

- The PTO issued a final Office Action dated October 24, 2007 (hereinafter the "Oct '07 Final Office Action").

In the Oct '07 Final Office Action, the Examiner stated that the Oct '07 Final Office Action is the first action following the filing of an RCE, but the Examiner nevertheless made the 2007 Final Office Action final alleging that "[a]ll claims are drawn to the same invention claimed . . . and could have been finally rejected on the grounds and art of record in the next Office action."

II. ARGUMENT:

A. Standards For Making A First Office Action Following An RCE Final:

As stated in the MPEP, the first office action following an RCE can be made final only if both of the following two conditions regarding the pending claims are met: "(1) [all claims] are drawn to the same invention claimed in the earlier application, and (2) [all claims] would have been properly finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application."¹ (MPEP 706.07(b).) As also set forth in the MPEP, no office action—whether a first or a second office action—containing new grounds of rejection can be made final unless an amendment by applicant necessitated the new grounds of rejection, or the new rejection is based on art first cited in an intervening Information Disclosure Statement ("IDS"). (MPEP 706.07(a).)

B. Whether The Finality Is Proper Should Be Determined With Respect To The Apr '07 Final Office Action

The Examiner's statement in the Oct '07 Final Office Action that it is the first action following the RCE of January 31, 2007 is incorrect. Rather, the Oct '07 Final Office Action is the third action by the PTO following the RCE of January 31, 2007. The first action is the Apr '07 Final Office Action, and the second action is the August 15, 2007 Decision to reopen prosecution. As compared to the Apr '07 Final Office Action, the Oct '07 Final Office Action includes the following new grounds of rejection:

¹ Logically, "earlier application" refers to the application prior to the filing of the RCE.

- Claims 16 and 17 rejected as anticipated by WO 99/14404 to Chen et al. ("Chen"); and
- Claim 1 rejected as anticipated by US Patent No. 5,613,861 to Smith et al. ("Smith I").

Thus, it would not be proper for the Examiner to make the Oct '07 Final Office Action final unless either an amendment filed by Applicants after the Apr '07 Final Office Action necessitated the new grounds of rejection or the new grounds of rejection are based on art first cited in an IDS filed after the Apr '07 Final Office Action. (MPEP 706.07(a).) Applicants neither amended the claims nor filed an IDS between the Apr '07 Final Office Action and the Oct '07 Final Office Action. Therefore, the foregoing new grounds of rejection could not have been either necessitated by an amendment to the claims or based on prior art submitted in an intervening IDS. For this reason alone, the finality of the Oct '07 Final Rejection is premature and should be withdrawn.

C. Even If The Propriety Of The Finality Of The Oct '07 Final Office Action Is Determined With Respect To The 2006 Final Office Action, The Finality Is Improper

Even if the Apr '07 Final Office Action and the August 15, 2007 Decision to reopen prosecution are ignored and the Oct '07 Final Office Action is deemed the first PTO action following the RCE filed January 31, 2007, the finality of the Oct '07 Final Office Action is premature.

Between the 2006 Final Office Action and the Oct '07 Final Office Action, Applicants amended claims 1, 16, 17, 90, and 91. Moreover, as compared to the 2006 Final Office Action, the Oct '07 Final Office Action includes at least the following new grounds of rejection:

- Claims 16 and 17 rejected as anticipated by Chen;
- Claims 1-3, 8, 9, 14, 15, 18, 19, 21, 90, and 91 rejected as obvious in view of Smith I and Chen.

Applicants respectfully assert that both of the conditions listed above for making a first action following an RCE final cannot be present. If Applicants' amendments to any of claims 1, 16, 17, 90, or 91 necessitated the new grounds of rejection, then claims 1, 16, 17, 90, and/or 91 cannot be deemed to be drawn to the "same invention," and the first condition necessary to make a first

action following an RCE final is not met. Moreover, if Applicants' amendments to claims 1, 16, 17, 90, and 91 are considered to be so insignificant as to leave those claims drawn to exactly the same invention as prior to the amendments, then those amendments could not have necessitated the new grounds of rejection in the Oct '07 Final Office Action, and the second condition necessary to make a first action following an RCE final is not met. Thus, given the fact that Applicants amended some of the claims and the Examiner responded with new grounds of rejection, the two conditions necessary to make a first action following an RCE final are mutually exclusive and therefore cannot be met. Put another way, the Examiner cannot state both that the claims are drawn to the same invention and amendments to the claims necessitated the new grounds of rejection. For this reason alone, the finality of the Oct '07 Final Office Action should be withdrawn.

III. CONCLUSION:

For the reasons discussed above, the finality of the Office Action dated October 24, 2007 should be withdrawn.

Respectfully submitted,

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